PATENT
09/843,059

D. REMARKS

Responsive to Examiner's Detailed Action item 2, Applicants exercise option to
file a reply under 37 CFR 1.111.

Applicants' attorney appreciates the opportunity to have had an interview with the
Examiner on November 10, 2004. Applicants' attorney presented the option to file
a Terminal Disclaimer concerning both the instant application and copending
patent application No. 09/843,063. Concerning this application, Applicant's
clarifications of claim 1 elements were discussed. In addition, a common
understanding was arrived at on the meaning of the term "rendered" as used in the
claim. Also discussed were Examiner's references cited in the Office Action, and
Applicants attorney particularly pointed out how the teachings of Engle in
combination with Pavley do not teach or suggest the claimed display of the
chronological list of multimedia objects.

Responsive to Examiner's Detailed Action item 3, the title of the invention is
amended herein.

Responsive to Examiner's provisional rejection of claims 1-4, 7-10, 13-16 and 19-
24 (Detailed Action item 5), as will be shown below, Applicants respectfully
submit that the subject matter claimed in the instant application is not fully
disclosed in the copending application No. 09/843,063, nevertheless a Terminal
Disclaimer is herein included.

Responsive to Examiner's Detailed Action item 8, Applicants confirm that the
subject matter of the instant claims was commonly owned at the time of invention.

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Claims 1, 2, 3, 4, 7, 8, 9, 10, 13, 14, 15, 16, 19, 20, 21, 22, 23, 24 remain

pending herein.

Claims 5, 6, 11, 12, 17, 18 have been previously canceled.

Claim Rejections – 35 U.S.C. § 103

Claims 1-4, 8-10, 13-16 and 19-24 stand rejected under 35 U.S.C. 103(a) as being

unpatentable over Engle et al. ("Engle", Pub. No.: US 2004/0024640) in view of Pavley et

al. ("Pavley", US6,317,141). Applicants respectfully traverse each rejection, and submit that

Examiner's rejections are overcome with the previous responses, and as clarified herein.

To establish a prima facie case of obviousness, three basic criteria must be met.[1] First, the

combination must teach or suggest all of Applicant's claim limitations.[2] Second, there

must be a suggestion or motivation to combine the references.[3] Finally, there must be a

reasonable expectation of success in the combination.[4]

Engle and Pavley

Claims 1-4, 8-10, 13-16 and 19-24 stand rejected under 35 U.S.C. 103(a) as being

unpatentable over Engle in view of Pavley. The combination of Engle and Pavley cannot

establish a prima facie case of obviousness because the proposed combination does not

teach or suggest each and every element of Applicants' pending claims, there is no

suggestion or motivation to make the proposed combination, and there is no reasonable

expectation of success in the proposed combination.

Neither Engle nor Pavley, Alone Or In Combination

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[1] Manual of Patent Examining Procedure §2142.
[2] *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).
[3] *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).
[4] *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).
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Teach Or Suggest All Of Applicants' Claim Limitations

Engle and Pavley, either alone or in combination does not teach or suggest all of Applicant's claim limitation. Concerning rejection of Applicants' claim 1, Examiner stated that Engle teaches Applicants' claimed "method for displaying, at a client, transient messages received over a network, the method comprising:

storing in a chronological list, independently of a user action, a plurality of different multimedia objects each containing at least one transient message when each multimedia object is initially rendered at the client." Examiner submitted that Engle teaches this element at "Engle, page 2, [0020]-[0022], AdCapture ... stored according to user-defined criteria, such as ... the date the ad was captured, etc., ... Ads stored in memory 24 can be sorted ... on the basis of the user-defined criteria)." Applicants submit that Engle does not teach or suggest Applicants' claim element, and instead teaches away for Applicants' claimed invention.

Engle Does Not Teach Or Suggest Applicants' Claimed Invention

Engle teaches that "ads are **not displayed** on the display device of browser 12 but are instead archived" (Engle []0020]). In contrast, Applicants claim provide for "storing...multimedia objects ...when each multimedia object is **initially rendered** at the client." Thus, Engle does not teach Applicants' claimed invention, and explicitly teaches away by teaching that ads are not rendered at the client, but that ads are archived instead of initially rendered as claimed by Applicants.

Engle teaches that "detected ads are diverted to memory 24 and the space that the ad would have occupied on the display device of browser 12 is instead filled with non-invasive, subdued background and small AdCapture signature" (Engle [0023]). Thus, Engle does not teach rendering any ad when storing the ad, and explicitly teaches diverting to memory and not rendering any ad., therefore, teaching away from Applicants' claimed element "storing in a

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chronological list, independently of a user action, a plurality of different multimedia objects each containing at least one transient message when each multimedia object is **initially rendered** at the client."

Engle teaches "a Save to Archive" menu, to offer the option of saving an ad by date, category or alphabetically...If the 'Save by Date' feature is selected in menu 28, a window 32 appears that enables the user to enter the date" (Engle [0027]). Thus, in order to store an ad by date, Engle presents a menu for the user to enter date information. Therefore, Engle does not teach Applicants' claimed invention, and teaches away from "storing in a chronological list, **independently of a user action...**" by requiring user action.

Engle teaches "a menu which allows a user to turn the AdCapture feature on or off. If the feature is turned on, the user is given the option of either viewing the ad or saving the ad in memory" (Engle [0025]). Thus, Engle does not teach applicants' claimed invention, and teaches away from Applicants' claimed invention by either allowing the user to save the ad, or to view the ad. In contrast, Applicants' claimed invention allows both "storing...**independent of a user action** multimedia objects...when each multimedia object is **initially rendered** at the client"

Engle teaches that for stored ads, "the AdCapture feature can prompt a user to view stored ads on a predetermined periodic basis. Failure to view such ads by the time such period expires can result in either the ads being deleted from memory 24 or the AdCapture feature being disabled until the captured ads are viewed" (Engle [0022]). Thus, Engle requires user action on a predetermined periodic basis otherwise the ad is deleted or the AdCapture Feature is disabled, so that no ads can be stored. Therefore, Engle does not teach or suggest Applicants' claimed invention, and instead teaches away from "**storing in a chronological list, independently of a user action...**" as claimed by Applicants.

Examiner admitted that Engle but does not explicitly disclose Applicants' claimed invention "displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in at least one of a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons,

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wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object." Examiner stated that "Pavley discloses creating a slide show for the captured multimedia objects (Pavley, col. 2, lines 15-20). A slide show such as Microsoft PowerPoint displays a list of multimedia objects in a forward succession at a user configurable rate." Applicants submit that Pavley does not teach or suggest Applicants' claimed invention.

Pavley Does Not Teach Or Suggest Applicants' Claimed Invention

Pavley teaches that "a user may import the images, and video directly into a presentation program such as Microsoft PowerPoint" (Col. 2, Lines 15-20). Nowhere does Pavley teach or suggest creating a slide show for "displaying the chronological list with control buttons..." as claimed by Applicants. Instead, Pavley teaches "a method... for creating and presenting a multimedia presentation...accomplished by navigating through several displays...**selecting and marking** the desired objects in the preferred order to create an ordered list of objects, and then saving the ordered list of objects as a slide show" Col. 8, Lines 50-62). Pavley does not teach or suggest "displaying the chronological list..." as claimed by applicants, and instead teaches away by navigating through several displays, selecting and marking the desired objects in the preferred order, and not displaying the chronological list as claimed by applicants.

Furthermore, Pavley teaches "three types of duration settings" (Col.16, Line 67, Col 17, Line 1) for specifying for each object "the duration the **media object** will be played back" (Col. 15, Lines 65-67). The specified duration of playback in Pavley is for each individual media object, and not "the chronological list...of stored multimedia objects...at a user configurable rate" as claimed by Applicants, thus teaching away from Applicants claimed invention.

In addition, Pavley teaches that "play mode causes each of the media objects included in the slide show to be individually played back on the display screen 140 in the sequence they were **marked** without user intervention" (Col . 11, Lines 57-65) thus, teaching away from

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"displaying the **chronological list** with control buttons for enabling subsequent rendering of the stored multimedia objects..." as claimed by Applicants.

Pavley teaches "in the case of slide show 360 created as metadata file, the slide show is played...**in the order listed in the file**" (emphasis added) (Col. 11, Line 66-Col. 12, Line 5). Thus, Pavley does not teach Applicants' claimed invention, and instead teaches away from "displaying the **chronological list** with control buttons for enabling a subsequent rendering of the stored multimedia objects,...wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object".

Moreover, Pavley teaches user defined events for presentation styles of slide show. "The first presentation style is to play back the media objects in the **order that they were marked** by the user during slide show creation" (emphasis added) (Col. 15, Lines 12-15). In Pavley "the second presentation style is **random access**, where the play back is controlled manually by the user" (emphasis added) (Col. 15, Line 19). Pavley teaches "the third presentation style is **branching**...During playback the user controls whether or not the branch should be taken" (Col. 15, Lines 39-43). Pavley teaches editing of the branch properties, so that "during playback, the user controls whether or not the branch should be taken." Thus, during the slide show, the sequence of displaying the objects is either a marked sequence, a random sequence, or a branching sequence. Nowhere does Pavley teach or suggest a slide show of a **chronological list** of the stored multimedia objects, and instead teach away from "displaying the chronological list" as claimed by Applicants.

The Combination of Engle and Pavley Does Not Teach Or Suggest Applicants' Claimed Invention

As shown above, neither Engle nor Pavley, alone or in combination teach or suggest the following claim limitations:

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"A method for displaying, at a client, transient messages received over a network, the method comprising:

storing in a chronological list, independently of a user action, a plurality of different multimedia objects each containing at least one transient message when each multimedia object is initially rendered at the client; and

displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in at least one of a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object."

Engle teaches that "ads are not displayed on the device of browser 12, but instead are archived" (Col. 2, [0020]). Even if the list of archived ads as taught by Engle was displayed using the slide show as taught by Pavley, the combination still fails to produce Applicant's claimed invention. Examiner admitted that "a slide show sequentially displays all the captured multimedia objects" (Office Action Page 5), but teaching a "sequential" slide show teaches away from a displaying a "chronological list" as claimed by Applicants. Furthermore, there is no teaching either in Engle or Pavley alone or in combination that would teach or suggest displaying "the chronological list with control buttons...at a user configurable rate...wherein the displayed control buttons are independent of any playback control" as claimed by Applicants.

No Suggestion or Motivation to Modify or to Combine Engle with Pavley

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Engle, or to combine Engle with Pavley. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Absent such a showing of suggestion or

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motivation, the Examiner has impermissibly used "hindsight" occasioned by Applicant's own teaching to reject the claims. *In re Surko,* 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck,* 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman,* 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond,* 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski,* 871 F,.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Examiner concludes, "Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a slide show presentation to display the captured multimedia objects in the system of Engle. A slide show sequentially displays all the captured multimedia objects so that the user does not need to select and play the multimedia object one at a time. It is much convenient for the user." (Office Action, page 4). There is no support in either reference for such a conclusion. In fact, as pointed out above, Engle explicitly teaches away from such storing and rendering independent of user action, and Pavley teaches away from creating a slide show presentation that displays the chronological list as claimed by Applicants.

Therefore, there is no suggestion or motivation to modify either Engle or Pavley, in order to combine Engle and Pavley to produce Applicants' claimed invention.

There Is No Reasonable Expectation Of Success In The Proposed Combination Of Engle With Pavley.

There is no motivation to modify or combine Engle with Pavley to produce Applicants' claimed invention because the proposed combination would change the principle of operation of Engle, and would render Engle unsatisfactory for its intended purpose. Since Engle's principle of operation is to either capture or display an ad, and explicitly teaches that **a captured ad is not to be displayed** but instead removed from the web page, this would render Engle unsatisfactory for its intended purpose if combined

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with Pavley which would **display** a slide show of an ad at the time the ad is stored, but Engle requires that an ad **not be displayed** when the ad is stored.

Furthermore, there is no motivation to modify or combine Engle with Pavley to produce Applicants' claimed invention because the proposed combination would change the principle of operation of Pavley, and would render Pavley unsatisfactory for its intended purpose. Since Pavley's principle of operation is for creating, editing and presenting a multimedia presentation of media objects, if combined with Engle, the slide show would not be displayed since Engle would require removing and not viewing the objects that are to be stored, thus Pavley would not have any objects to display in a slide show.

Thus, Applicants submit that there is no suggestion or motivation to combine Engle with Pavley to produce Applicant's claimed invention because the combination of the teachings of Engle and Pavley render both the Engle and Pavley teachings unsatisfactory for their intended purpose. *In Re Tatti*, 270 F2d 810, 123 USPQ 349 (CCPA 1959), *in re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Therefore, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 USC 103(a) with respect to claim 1. Withdrawal of the rejection of claim 1 is respectfully requested.

Responsive to Examiner's rejection of dependent claims 2, 3, 4, 7, 8 and 9 Applicants respectfully submit that the Examiner has not proven prima facie obviousness for claim 1, and therefore dependent claims 2, 3, 4, 7, 8 and 9 which depend from claim 1 should be allowed.

Responsive to Examiner's rejection of claims 10, 13-16 and 19-20, Applicant's response is similar to Applicant's response made for corresponding claims 1-4 and 8-9. Therefore, Applicant respectfully submits that the Examiner has not proven prima facie

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obviousness for claims 1-4 and 8-9, and therefore corresponding claims 10, 13-16 and 19-20 should be allowed.

Responsive to Examiner's rejection of claim 21, Examiner makes reference to Engle, page 2, [0020]-[0024] concluding that Engle teaches "storing in a chronological list, independently of a user action, each transient message when each transient message is initially rendered by the browser." Applicants response above submit that Engle does not teach this element, and instead teach away from this element. In particular, Engle teaches that "detected ads to be captured... are **not displayed** on the display device of browser 12, but are instead archived" (Engle, [0020]). Thus, Engle does not teach that ads are **redisplayed**, and instead teach away from redisplaying any such object as claimed by Applicants.

Also, as responded above with regards to claim 1, there is no motivation to modify or combine Engle and Pavley to produce Applicants' claimed invention, and Applicants submit that there is no suggestion or motivation to combine Engle with Pavley to produce Applicants' invention as claimed in claim 21.

Therefore, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 USC 103(a) with respect to claim 21. Withdrawal of the rejection of claim 21 is respectfully requested.

Responsive to Examiner's rejection of dependent claims 22, 23 and 24, Applicants respectfully submit that the Examiner has not proven prima facie obviousness for claim 21, and therefore dependent claims 22, 23, 24 which depend from claim 21 should be allowed.

Responsive to Examiner's rejection of dependent claim 7, as responded above, Applicants submit that there is no motivation to modify or combine Engle with Pavley

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and, no further motivation or suggestion to combine with Olah to produce Applicants' claimed invention. The proposed combination would change the principle of operation of Engle, and would render Engle unsatisfactory for its intended purpose. Engle's principle of operation is to either capture or display an ad, and explicitly teaches that **a captured ad is not to be displayed** but instead removed from the web page, this would render Engle unsatisfactory for its intended purpose if combined with Pavley which would **display a slide show of an ad when the ad is stored**. Olah teaches monitoring computer usage (Col. 4, Lines 28-35) saving "screens in certain times" (Olah, Fig 2-3).

Any proposed combination of the teachings of Olah with Engle with or without Pavley would still render Engle unsatisfactory for its intended purpose because Engle requires no display of a captured image, and thus would teach away from Applicants' claimed invention. Also, Olah teaches a "capturing the content on a display screen" (Col. 1, Lines 10-15), via a "screen capture interface...at which screen captures are to be executed" (Col 6, Lines 33-40). Thus, Olah is concerned with "screen captures" and not with "multimedia objects" as claimed by Applicants. Therefore, any combination of Engle with Pavley and Olah would still not produce Applicants' claimed invention.

Therefore, Applicants respectfully submit that the Examiner has not proven prima facie obviousness for claim 1, and therefore dependent claim 7 which depends from claim 1 should be allowed.

Conclusion

All of the currently pending claims are deemed to be patentable for the reasons discussed above.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending

claims could be allowed with minor changes, the Examiner is invited to telephone the

undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

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